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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,339	03/09/2001	Richard A. Wiltshire	122923-1000	7334

32914 7590 05/16/2005

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EXAMINER

MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/803,339

Applicant(s)

WILTSHIRE ET AL.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24, 29-31 and 45-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 30, 31 and 45-51 is/are allowed.
- 6) ☒ Claim(s) 1-24 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6-18-2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**



**Claims 1-24, 29-31 and 45-51 are pending.**

**This action is non-final.**

**In response to the RCE dated April 1<sup>st</sup> 2005.**



***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 1<sup>st</sup> 2005 has been entered.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **1-14** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The preamble of the claims recites "a system for lottery pool management over a communication network", however, the structure of the claim recites a series of "interface" components. An interface is no more than a software module intended to perform specific functions, and is thus no more than a computer program per se. These

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software modules are not embodied on any type of computer-readable medium or other tangible embodiment. A computer program claimed absent the appropriate structure to cause its functionality is directed to functional descriptive material, as defined by MPEP §2106 and is directed to non-statutory subject matter as such.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **15-24**, and **29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Texas Lotto Club Website in view of Scagnelli (US 5,910,047) in further view of Applicant's admitted prior in art.

The method of claims **15-22** as presented is deemed to remain under the automation of a previous manual task when considered in view of the applicant's admitted prior art.

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merely using a computer to automate a known process does not by itself impart

nonobviousness to the invention. See *Dann v. Johnston*, 425 U.S. 219, 227-30,

189 USPQ 257, 261 (1976); *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194

(CCPA 1958),<sup>2</sup> (MPEP 2106. VI)

Specifically the admitting of a plurality of participants into a lottery pool by way of respective computers, the recordation of lottery number sets by a management computer, allowing the contribution of sets of lottery numbers, comparing the results of the lottery with the sets of lottery numbers, and notifying the pool participants via their respective computer of a win and entitlement to a share of the resultant winnings all represent a computer equivalent step to the implementation of a lottery pool and equivalently here the automation of previously manual tasks associated with a lottery pool. Later claims **17-22** further incorporate the use of electronic mail, passwords, time tracking, the Internet and a highlighted display of lottery number matches, however fail to provide functionality absent from the manual operation of the method. As such the method as set forth in claims **15-22** is equated to the corresponding steps of the of a lotto pool as disclosed by applicant in at least paragraph 5 of their specification automated through the use of a computer.

The program of claims **23-24, and 29** is recognized as an equivalent to the above method for merely providing a means of computer automation.

### ***Response to Arguments***

Applicant's arguments, filed April 1<sup>st</sup>, 2004, with respect to claims **30-31**, and **45-51** have been fully considered and are persuasive. Accordingly the rejection of these claims has been withdrawn.

Remaining arguments directed to the method and software product of claims **15-24**, and **29** are non-persuasive for failing to incorporate any elements beyond the known steps of the prior art lottery pools and providing a mere utilization of computers to automate the previously known process. Further elements including use of the internet and/or email are a) well known device in the art, b) understood as a reasonable inclusion to the process of automation, and c) cannot overcome obviousness when applied in traditional manners such as using email to communicate with a user.

The applicant's delineation of system components with associated functionality as found in claims **30-31**, and **45-51**, provides sufficient structure to overcome obviousness.

### ***Allowable Subject Matter***

Claim **30-31**, and **45-51** are allowed.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Texas Lotto Club © 1997 [www.texaslottoclub.com](http://www.texaslottoclub.com) - teaches an online lotto pool.

US 5,910,047 Scagnelli et al teaches a computerized lottery wagering system.

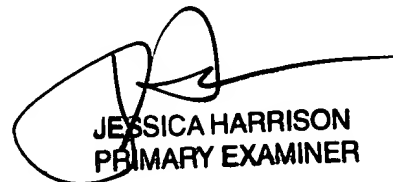
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM



JESSICA HARRISON  
PRIMARY EXAMINER